

Serial No. 10/645,814

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**REMARKS****Status of the Claims**

The claims in this application are claims 1-35.

**Claims 1-35**

Claims 1-35 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Brown US 6,123,681 in view of Shabty et al. US 2005/0137507 (Shabty), Madden et al. US 6,249,076 (Madden) and Hegde et al. US 2004/0230090 (Hegde). This rejection is respectfully traversed.

Brown discloses anti-embolism stockings controlled by electroactive polymers, per se. The type of actuator required by the instant claims is nowhere disclosed in the Brown patent. Brown is also silent with regard to the ability of the disclosed stockings to function in synchrony with the heartbeat of the user.

Shabty discloses an inflatable cuff or plurality of inflatable cuffs for counterpulsation therapy, without the need for compressed air. The cuffs of Shabty are completely different from the stockings of Brown in appearance, basis of operation (inflation vs. material constriction), and purpose of operation (counterpulsation therapy vs. embolism prevention).

The disclosure of Hegde relates to an entirely different type of device from those of Brown, Shabty, and the present claims. The device of Hegde is implanted in the body of a patient.

Madden discloses electroactive polymer actuators of the type recited in some of the present claims. However, the practical application disclosed in Madden involves the use of a maximum number of two actuators to turn a bearing in a mechanical device. There is no suggestion of how the disclosed actuators could be used in any greater number in anti-embolism stockings such as those disclosed by Brown.

On this basis, it is respectfully submitted no suggestion and motivation to combine the references can be found within them. In re Jones, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1943-44 ( Fed. Cir. 1992), In re Fine, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1598-99 (Fed. Cir. 1988). Combination of various selected pieces of the reference teachings without such suggestion/motivation can be based only on undue

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hindsight. See MPEP 2142, second paragraph, and the cases cited therein. In particular, see *Akso N.V. v. U.S. International Trade Commission*, 808 F.2d 1241, 1480-81, 1 U.S.P.Q.2d, 1241, 1246 (Fed. Cir. 1986), *cert. denied*, 482 U.S. 909 (1987), *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861, 874, 228 U.S.P.Q. 90-99 (Fed. Cir. 1985).

Furthermore, even if the reference teachings were combined, the invention of the instant claims would not result.

The Examiner has now stated that the Brown teaching of sequential compression is "clearly" for "synchronized compressions." That statement is erroneous. The sequential compressions are necessary to "mimic the pulsatile milking action of leg muscles" lacking in the prior art. Compare column 3, lines 30-33, with column 1, lines 54-58. It is not disclosed, nor does it appear necessary, for the sequential pulsation to be synchronous with heartbeat to provide the effect desired by Brown.

Furthermore, none of the references cited by the examiner appears to teach or suggest a feedback component that senses a feedback characteristic and provides a feedback signal indicative of the sensed feedback characteristic as claimed in claims 10-14, 28 and 29. For example, as noted at page 10 of the specification, such a feedback signal can be used to shift the location and timing of the applied pressure using the actuators in order to maximize the flow response achieved or the metabolic benefit achieved by the system.

Reconsideration and withdrawal of the rejection of claims 1-35 under 35 U.S.C. 103(a) are respectfully requested.

#### **Provisional Obviousness-type Double Patenting**

The provisional double patenting rejections made by the Examiner noted. However, these rejections are not yet ripe for argument as the patent applications at the heart of the rejection have yet to issue as U.S. patents. Indeed, at a future time, the provisional double patenting rejections may become the only rejections remaining in the present application, in which case the rejection will be withdrawn in accordance with the provisions of MPEP 804 (emphasis added):

Occasionally, the examiner becomes aware of two copending applications...that would raise an issue of double patenting *if one of the applications became a*

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*patent.* ... The merits of such a provisional rejection can be addressed by both the applicant and the examiner without waiting for the first patent to issue.

The "provisional" double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that "provisional" double patenting rejection is the only rejection remaining in one of the applications.

*If the "provisional" double patenting rejection in one application is the only rejection remaining in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the "provisional" double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent.*

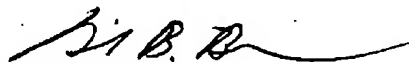
### Conclusion

In light of the above remarks, applicant believes that all of the rejections of record have been obviated, and allowance of this application is respectfully requested.

### Fees

The Examiner is authorized to any fees that may be due to the undersigned attorney's PTO Deposit Account #50-1047.

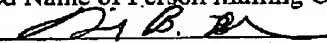
Respectfully submitted,



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I hereby certify that this document and any document referenced herein is being sent to the United States Patent and Trademark office via Facsimile to: 571-273-8300 on Oct. 11, 2006.

David B. Bonham  
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(Signature)